REMARKS

Claims 1-44 are pending. Claims 1-7, 11, 13-20, 22, 23-29, 31-38 and 40-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,742,763 to Jones in view of U.S. Patent No. 5,327,486 to Wolff et al. Claims 8, 9, 21, 30, 39 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,742,763 to Jones in view of U.S. Patent No. 5,327,486 Wolff et al. and U.S. Patent No. 6,092,102 to Wagner.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 1, 7, 9, 13-14, 17, 20-23, 29-32, and 38-40 are amended to clarify the invention. Claims 1-44 remain in the case for consideration.

REJECTIONS UNDER 35 U.S.C. § 103(a)

In rejecting the claims, the Examiner has changed from Zothner (the previous reference) to Jones. Jones, however, teaches even fewer features than Zothner did. Specifically, Jones does not teach the concept of a persistent store, as claimed. The Examiner cites to column 3, lines 27-35 as teaching the concept of a persistent store. But that section of Jones discusses vector space models and database query techniques. A persistent store is an entirely different concept from these. Persistent stores are described on page 4, lines 4-10 of the specification, and include the capabilities of objects not losing properties, and notification services as the objects are inserted. These features are decidedly absent from the vector space models and database query techniques mentioned by Jones. And to argue that because it might be possible to construct a persistent store using a vector space model or a database query technique (something that the Applicant neither suggests nor denies) that such concepts teach a persistent store is to apply hindsight. Jones does not describe the construction of vector space models or database query techniques, nor any properties of such constructs, and so cannot teach or suggest a persistent store as claimed.

In addition, Jones makes it clear that the "software agents [are] associated with the handle" (column 6, lines 26-27; *see also* column 6, lines 35-36 and column 9, lines 17-21). Jones states that "[a]n entity obtains services through its handle . . . . Service providers . . . then add the service capabilities to the handle in an appropriate manner . . . ." (column 6, lines 17-23). In other words, the software agents that Jones describes are associated with individual entities, such as messages. In contrast, as is well documented in the specification and now claimed, the message-processing agent is independent of the object: the "service" it provides (using the language of Jones) can be utilized by any appropriate object, but the agent itself is not "associated" with any particular object. Thus, Jones cannot teach or suggest a message-processing agent independent of an object, as claimed.

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Finally, Wolff discusses a telecommunications messaging system. Wolff does not mention wrappers at all. It is worth noting that in rejecting claims, the Examiner has discussed sections of Wolff that describe a personal preferences setting indicating a second destination for an object. The Examiner then argues that the new destination would "force the system to re-wrap the message object in a new envelope" (Office Action dated May 3, 2005, page 3).

To make this reasoning work, the Examiner has introduced elements that are not taught in Wolff. For example, Wolff does not use the terms "wrap" or "envelope". The Examiner appears to be arguing by analogy from the way ordinary mail is transmitted. But in the real world, if a letter needs to be re-mailed, the original envelope has been opened and is not reusable, and new postage would be required. There are no analogous requirements in the transmission of data, and Wolff does not discuss or even suggest that they are needed or even useful. Since Wolff does not teach or suggest the features of the claims, the Examiner's reasoning is unsupported. Thus, not only are the claims not obvious over Jones in view of Wolff, but the Examiner has failed to satisfy the prima facie requirement for obviousness.

Because Jones and Wolff fail to teach or suggest the concepts of a persistent store and object wrappers, claims 1, 13, 22, 31, and 40 are patentable under 35 U.S.C. § 103(a) over Jones in view of Wolff. Therefore, claims 1, 13, 22, 31, and 40, and dependent claims 2-12, 14-21, 23-30, 32-39, and 41-44, are allowable.

REBUTTAL TO EXAMINER'S RESPONSE TO ARGUMENTS

The Examiner has argued that the recitation "'further including a Community Service, the Community Service capable of cling the message-processing agent' has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone". The Examiner cites to *In re Hirao*, 535 F.2d 67, 190 U.S.P.Q. 15 (C.C.P.A. 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (C.C.P.A. 1951).

The Examiner's summary is almost verbatim from *In re Hirao*. But in *In re Hirao*, the court was able to find the steps non-obvious without reference to the preamble. Thus, the *Hirao* court never needed to reach the question of what patentable weight to assign to the preamble. Further, the Solicitor was attempting to broaden the claim by the interpretation of the preamble, which the court said was impermissible. In contrast, the limitation in question here does not broaden the claims: it narrows the claims. And if the Examiner were correct that the other

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features of the claim were obvious over the cited references (a position the Applicant disputes for the reasons stated above), then the language in the preamble might make a difference in whether the claims are allowable.
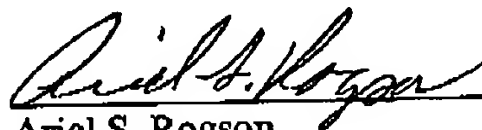
In addition, the preamble does not "merely recite[] the purpose of a process or the intended use of a structure". The clause in question describes how the service can clone the message-processing agent, whose features are described in the claim. Thus, the prerequisite for according the preamble no patentable weight is not met.

Even the MPEP supports this position. The MPEP goes even further, mandating the preamble be accorded patentable weight when appropriate. According to MPEP § 2111.02, "[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." As the clause in question limits the structure of the claimed invention by limiting the applicability of the message-processing agent to services which are capable of cloning the message-processing agent, the clause in question should be accorded patentable weight.

Nevertheless, in the hopes that it will clarify the claims, features of the claimed invention that were previously in the preamble have been added as specific features of the claims. In addition, these features have been clarified by including language from the specification that explained these features. Accordingly, these features should now be given patentable weight by the Examiner.

For the foregoing reasons, reconsideration and allowance of claims 1-44 of the application as amended is solicited. **The Applicant believes an interview would assist in the examination of this application, and the Examiner is requested to telephone the undersigned at (503) 222-3613 to schedule an interview.**

Respectfully submitted,
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